



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,579	09/23/2003	Gustav Tappe	07244-00144-US	3905

23416 7590 03/11/2005

CONNOLLY BOVE LODGE & HUTZ, LLP  
P O BOX 2207  
WILMINGTON, DE 19899

EXAMINER

LE, HOA VAN

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/668,579

Applicant(s)

TAPPE ET AL.

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/10&17/04 & 26/01&7/02/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-24,28-38,40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) 13-24,28,38,40 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 13-24,28,38,40 and 41 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. 09/865,880.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

This is in response to Paper filed on 10 and 17 December 2004 and 26 January and 07 February 2005.

I. Applicant's election with traverse of the invention of Group II, claims 29-37 in the reply filed on 07 February 2005 is acknowledged. The traversal is on the ground(s) that the searches of all Groups of the inventions are in the same or in about the same area. This is not found persuasive because the searches for each Group of the invention are different and distinct from any of the others. An additional search in an additional invention is burdensome.

The requirement is still deemed proper and is therefore made FINAL.

II. This application contains claims 13-24, 28, 38, 40 and 41 are drawn to inventions nonelected with traverse in Paper filed on 07 February 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

III. The amendments filed 10 and 17 December 2004 are objected to under 35 U.S.C. 132 because they introduce new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

(1) In claim 34 with "a buffer substance", (2) in claim with 35 with "organic", (3) in claim 36 with "phosphonic" and (4) in claim 37 with "organic"... "is maleic", they are not

Art Unit: 1752

supported in the cited location as indicated by applicants. The record shows that this is not the first time new matters are added.

Applicant is required to cancel the new matter in the reply to this Office Action.

IV. Claims 34-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(1) In claim 34 with “a buffer substance”, (2) in claim with 35 with “organic”, (3) in claim 36 with “phosphonic” and (4) in claim 37 with “organic”... “is maleic”, they are not supported in the cited location as indicated by applicants. The record shows that this is not the first time new matters are added.

V. Applicants point out that three English language translations of the priority documents are on the record. However, time after time applicants could not be able to provide each of the embodiment in the claims is supported from a single English language translation of the priority document as set forth and requested on the record. Each of the English language translations of the priority documents has been careful studied. None of them is sufficiently supported for the embodiments of the elected invention of claims 29-37. Accordingly, for at least the reason in paragraphs “III” and/or “IV” above, Papai (6,455,236) is properly applied.

Art Unit: 1752

VI. The history of the prosecutions including applicants' amendments and arguments have been reviewed. No originally filed claim set of the parent application Serial No. 09/865,880 is on the record in this application. Instead, applicants file an amended claim set only. Accordingly, applicants cannot use a support from the originally filed claim set until it is on the record in this application.

VII. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 29-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Papai (6,455,236).

Papai discloses, teaches, demonstrates and reduces to practice with a process of making a ready-to-use solution by process of making a concentrate as elected and claimed by applicants. A making up a concentrate bleach-fixing composition comprises the steps of providing a sufficient amount of a bleaching agent, a sufficient amount of a fixing agent and a sufficient amount of a phosphate ions to provide a stable composition without any crystal formation. The composition is diluted with an appropriate amount of water to form a read-to-use bleach-fixing solution before use. Please see the whole disclosure or the applied reference, especially at col.1:49-51, 3:39-41 and 49-51, 4:53 to 5:7 and 20-25, 8:20-21, 9:7-8 and 41-65 and Example 5 and 6. Since

Art Unit: 1752

Papai discloses, teaches, demonstrates and reduces to practice with the claimed embodiments, the above claims are found to be anticipated by Papai.

VIII. Claims 29-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papai (6,455,236).

Papai discloses, teaches and suggests a process of making a ready-to-use solution by process of making a concentrate as elected and claimed by applicants. A making up a concentrate bleach-fixing composition comprises the steps of providing a sufficient amount of a bleaching agent, a sufficient amount of a fixing agent and a sufficient amount of a phosphate ions to provide a stable composition without any crystal formation. The composition is diluted with an appropriate amount of water to form a read-to-use bleach-fixing solution before use. Please see the whole disclosure or the applied reference, especially at col.1:49-51, 3:39-41 and 49-51, 4:53 to 5:7 and 20-25, 8:20-21, 9:7-8 and 41-65 and Examples 5 and 6. For the disclosed, taught and suggested embodiments without demonstration or reduction to practice, they are also applied to be rendered prima facie obvious by teachings and suggestions in Papai.

IX. The record shows that the bleach-fixing concentrate of the invention as originally filed in the parent application Serial no. 09/865,880 require a amount of from 0.2 mol/l of a bleaching agent, from 0.5 mol/l of a fixing agent and 0.01 mol/l a phosphate (including phosphoric acid in priority document 100 39 719.0 only) (not phosphate ions). Evidence can be seen in the parent application as originally filed, especially at the originally filed set of the claims. An originally filed set of the claims has not been provided for the record in this

Art Unit: 1752

application). The concentrations of the claimed bleaching agent and fixing agent are much less than the read-to-use bleach-fixing solution in the art. Evidence can be seen in Kato et al (EP 0 532 042) at page 70, lines 31-45. The step of diluting with water in the claimed invention before use is considered but has and is given a little patentable distinction or value with respect to concentrations of the bleaching agent and fixing agent in the ready-to-use bleach-fixing solution as compared to those in the bleach-fixing concentrate since there is no proportion of water to be added to the bleach-fixing concentrate. It is broadly open to any imaginably infinitesimal amount of water, such as one drop of water, is added to a tank having about 100 gallon of the bleach-fixing concentrate. Until applicants clearly set forth a ratio of an amount of water to be added to an amount of the bleach-fixing concentrate, a tiny amount of water is sufficiently, properly and appropriately applied to the claimed invention as broadly disclosed and claimed.

XII. The process of making a ready-to-use solution by process of making a concentrate as elected and claimed by applicants has a patentable value on the process of making a ready-to-use only. Until applicants provide evidence to show that the process of making the concentrate would convincingly provide a patentably distinct read-to-use solution from each of the applied ready-to-use solutions in accordance with the analogous decision with respect to product-by-process in *In re Brown*, 173 USPQ 685 or *In re Thorpe*, 227 USPQ 964.

XIII. Claims 29-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meckl et al (3,293,036) considered in view of Papai (6,455,236).

The record shows that the bleach-fixing concentrate of the invention as originally filed in the parent application Serial no. 09/865,880 require a amount of from 0.2 mol/l of a bleaching agent, from 0.5 mol/l of a fixing agent and 0.01 mol/l a phosphate (including phosphoric acid in priority document 100 39 719.0 only) (not phosphate ions). Evidence can be seen in the parent application as originally filed, especially at the originally filed set of the claims. An originally filed set of the claims has not been provided for the record in this application). The concentrations of the claimed bleaching agent and fixing agent are much less than the read-to-use bleach-fixing solution in the art. Evidence can be seen in Kato et al (EP 0 532 042) at page 70, lines 31-45. The step of diluting with water in the claimed invention before use is considered but has and is given a little patentable distinction or value with respect to concentrations of the bleaching agent and fixing agent in the ready-to-use bleach-fixing solution as compared to those in the bleach-fixing concentrate since the is no proportion of water to be add to the bleach-fixing concentrate. It is broadly open to any imaginably infinitesimal amount of water, such as one drop of water, is added to a tank having about 100 gallon of the bleach-fixing concentrate. Until applicants clearly set forth a ratio of an amount of water to be added to an amount of the bleach-fixing concentrate, a tiny amount of water is sufficiently, properly and appropriately applied to the claimed invention as broadly disclosed and claimed.

The process of making a ready-to-use solution by process of making a concentrate as elected and claimed by applicants has a patentable value on the process of making a ready-to-use only. Until applicants provide a evidence to show that the process of making the concentrate would convincingly provide patentably distinct read-to-use solution from the each of the applied



Art Unit: 1752

ready-to-use solution in accordance with the analogous decision with respect to product-by-process in *In re Brown*, 173 USPQ 685 or *In re Thorpe*, 227 USPQ 964.

Meckl et al disclose, teach and suggest a process of making a ready-to-use solution by process of making a concentrate as elected and claimed by applicants. A making up a concentrate bleach-fixing composition comprises the steps of providing a sufficient amount of a bleaching agent, a sufficient amount of a fixing agent and a sufficient amount of a phosphate ions. The composition is diluted with an appropriate amount of water to form 1 liter of a ready-to-use bleach-fixing solution before use. Please see the whole disclosure or the applied reference, especially at col.1:38-40, 2:55 to 3:2 and 23-35.

Meckl et al do not specify the conventional additives of phosphoric acid in claim 36 and maleic acid in claim 37. Papai at col.4:53-54 and 9:7-8 discloses, teaches and suggests the use of the cited acidic compounds to provide a desired pH solution.

Since the above references are all related to processes of making the combined functions of the bleach-fixing solutions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the use of the acidic compounds from Papai for a reasonable expectation of provide a proper pH solution as disclosed, taught, suggested and obtained in Papai.

XIV. Claims 29-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohkubo (3,591,380) considered in view Papai (6,455,236).

The record shows that the bleach-fixing concentrate of the invention as originally filed in the parent application Serial no. 09/865,880 require a amount of from 0.2 mol/l of a bleaching

Art Unit: 1752

agent, from 0.5 mol/l of a fixing agent and 0.01 mol/l a phosphate (including phosphoric acid in priority document 100 39 719.0 only) (not phosphate ions). Evidence can be seen in the parent application as originally filed, especially at the originally filed set of the claims. An originally filed set of the claims has not been provided for the record in this application). The concentrations of the claimed bleaching agent and fixing agent are much less than the read-to-use bleach-fixing solution in the art. Evidence can be seen in Kato et al (EP 0 532 042) at page 70, lines 31-45. The step of diluting with water in the claimed invention before use is considered but has and is given a little patentable distinction or value with respect to concentrations of the bleaching agent and fixing agent in the ready-to-use bleach-fixing solution as compared to those in the bleach-fixing concentrate since there is no proportion of water to be added to the bleach-fixing concentrate. It is broadly open to any imaginably infinitesimal amount of water, such as one drop of water, is added to a tank having about 100 gallon of the bleach-fixing concentrate. Until applicants clearly set forth a ratio of an amount of water to be added to an amount of the bleach-fixing concentrate, a tiny amount of water is sufficiently, properly and appropriately applied to the claimed invention as broadly disclosed and claimed.

The process of making a ready-to-use solution by process of making a concentrate as elected and claimed by applicants has a patentable value on the process of making a ready-to-use only. Until applicants provide evidence to show that the process of making the concentrate would convincingly provide patentably distinct read-to-use solution from each of the applied ready-to-use solution in accordance with the analogous decision with respect to product-by-process in *In re Brown*, 173 USPQ 685 or *In re Thorpe*, 227 USPQ 964.

Ohkubo et al disclose, teach and suggest a process of making a ready-to-use solution by process of making a concentrate as elected and claimed by applicants. A making up a concentrate bleach-fixing composition comprises the steps of providing up to 50 g/l of a bleaching agent, up to 500 g/l of a fixing agent and a sufficient amount of a phosphate ions. The composition is diluted with an appropriate amount of water to form 1 liter of a read-to-use bleach-fixing solution before use. Please see the whole disclosure or the applied reference, especially at col.2:66-68, 3:1-4 and Example 2.

Ohkubo et al do not specify the conventional additives of phosphoric acid in claim 36 and maleic acid in claim 37. Papai at col.4:53-54 and 9:7-8 discloses, teaches and suggests the use the cited acidic compounds to provide a desired pH solution.

Since the above references are all related to processes of making the combined functions of the bleach-fixing solutions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the use of the acidic compounds from Papai for a reasonable expectation of provide a proper pH solution as disclosed, taught, suggested and obtained in Papai.

XV. Claims 29-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schranz et al (3,879,203) considered in view Papai (6,455,236).

The record shows that the bleach-fixing concentrate of the invention as originally filed in the parent application Serial no. 09/865,880 require a amount of from 0.2 mol/l of a bleaching agent, from 0.5 mol/l of a fixing agent and 0.01 mol/l a phosphate (including phosphoric acid in priority document 100 39 719.0 only) (not phosphate ions). Evidence can be seen in the parent

Art Unit: 1752

application as originally filed, especially at the originally filed set of the claims. An originally filed set of the claims has not been provided for the record in this application). The concentrations of the claimed bleaching agent and fixing agent are much less than the read-to-use bleach-fixing solution in the art. Evidence can be seen in Kato et al (EP 0 532 042) at page 70, lines 31-45. The step of diluting with water in the claimed invention before use is considered but has and is given a little patentable distinction or value with respect to concentrations of the bleaching agent and fixing agent in the ready-to-use bleach-fixing solution as compared to those in the bleach-fixing concentrate since there is no proportion of water to be added to the bleach-fixing concentrate. It is broadly open to any imaginably infinitesimal amount of water, such as one drop of water, is added to a tank having about 100 gallons of the bleach-fixing concentrate. Until applicants clearly set forth a ratio of an amount of water to be added to an amount of the bleach-fixing concentrate, a tiny amount of water is sufficiently, properly and appropriately applied to the claimed invention as broadly disclosed and claimed.

The process of making a ready-to-use solution by process of making a concentrate as elected and claimed by applicants has a patentable value on the process of making a ready-to-use only. Until applicants provide evidence to show that the process of making the concentrate would convincingly provide patentably distinct read-to-use solution from each of the applied ready-to-use solution in accordance with the analogous decision with respect to product-by-process in *In re Brown*, 173 USPQ 685 or *In re Thorpe*, 227 USPQ 964.

Schranz et al disclose, teach and suggest a process of making a ready-to-use solution by process of making a concentrate as elected and claimed by applicants. A making up a concentrate bleach-fixing composition comprises the steps of providing a sufficient amount of a bleaching

Art Unit: 1752

agent, a sufficient amount of a fixing agent and a sufficient amount of a phosphate ions. The composition is diluted with an appropriate amount of water to form 1 liter of a read-to-use bleach-fixing solution before use. Please see the whole disclosure or the applied reference, especially at col.4:11-16 and Example 1 .

Schranz et al do not specify the conventional additives of phosphoric acid in claim 36 and maleic acid in claim 37. Papai at col.4:53-54 and 9:7-8 discloses, teaches and suggests the use the cited acidic compounds to provide a desired pH solution.

Since the above references are all related to processes of making the combined functions of the bleach-fixing solutions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the use of the acidic compounds from Papai for a reasonable expectation of provide a proper pH solution as disclosed, taught, suggested and obtained in Papai.

XVI. Applicants' arguments have been carefully considered but are not found to be convincing.

It is correct that there are three English language translations of the priority documents are on the record. However, time after time applicants could not be able to provide each of the embodiment in the claims is supported from a single English language translation of the priority document as set forth and requested on the record. Each of the English language translations of the priority documents has been careful studied. None of them is sufficiently supported for the embodiments of the elected invention of claims 29-37. Accordingly, for at least the reason in paragraphs "III" and/or "IV" above, Papai (6,455,236) is properly applied.

Art Unit: 1752

For the arguments with respect to the sets of the prior art applications in the previous Office action, they have a little value with respect to the newly elected invention of claims 29-37, searches and application with Papai alone and/or set of the applied references since they are distinctively applied as compared the those in the previous Office action.

XII. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

XIII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

Art Unit: 1752

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
09 March 2005

HOA VAN LE  
PRIMARY EXAMINER  
